



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/244,669 09/14/88 GIANTURCO

C-3:21:AMD  
EXAMINER

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ART UNIT PAPER NUMBER  
11

336  
DATE MAILED:

09/26/90

This is a communication from the examiner in charge of your application  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 6/8/90 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 3 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>  |

Part II SUMMARY OF ACTION

1. ☒ Claims 28-31, 33 AND 34 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 28-31, 33 and 34 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable, ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved, ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Serial No. 244,669

-2-

Art Unit 336

Applicant's remarks on pages 4 and 5 of the response (06/05/90) regarding applicant's co-authorship of the previously noted articles has been found persuasive. The affidavits submitted by Dr. Cesar Gianturco and Kenneth Wright, PH.D, (12/28/88) sufficiently establish the sole inventorship of Dr. Gianturco and effectively remove the question of patentability under 35 USC 102 (f) or (g).

Claims 28-31, 33, and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 4,800,882. Although the conflicting claims are not identical, they are not patentably distinct from each other because the device and method set forth in the '882 claims would inherently remain a constant length and would meet the broader limitations of the present claims.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or

on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31, 33, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by each of the following published articles: "Expandable intraluminal vascular graft: A feasibility study", "Expandable Intraluminal Graft: A Preliminary Study", and "Expandable Intrahepatic Portacaval Shunt Stents".

Applicant has attempted to distinguish the presents claims from the aforementioned publications coauthored by Palmaz by adding the limitation that "at least some of said plurality of elongate members ... being deformed by the outwardly extending force" and with the submission of a 35 CFR 1.132 declaration by Paul Eaton, a Professor of Materials Engineering at Purdue University. The examiner is not persuaded for several reasons. First, the article titled "Expandable intraluminal vascular graft: A feasibility study" on page 204 (second column) discloses construction of a stent by etching thin-walled stainless steel tubing in a lath design which is deformed when expanded. This design as illustrated in Figures 2A and 2B of the Palmaz patent meets the claim limitations. Second, the declaration by Professor Eaton is not overly persuasive as it (1) contradicts the "Expandable Intrahepatic ... Stent" statement that there is deformation of the wire segments between soldered points, (2) is based in part on the illustrations in Figures 1A and 1B of the Palmaz patent which has long been held to be schematic

representations rather than actual exact representations, (3) Figure 1 of the "feasibility study" article appears to illustrate the elongated mesh wires in a deformed configuration when expanded (note the curved lines not appearing in the unexpanded Figure), and (4) while the examiner agrees with Professor Eaton that silver has a much lower modulus of elasticity than stainless steel, the examiner points to the discussion on page 822 of the "Intrahepatic" article which discloses that the stainless steel wire is very small .015mm compared to the stent wall thickness of .35mm to .45mm. Whether the solder joints deform or the wire deforms depends not only on the elasticity of the material but the cross-sectional area of the material through which the force acts. In this case, the examiner will contend, that short of actual tests on the Palmaz stent, the out come of which will deform is almost impossible to predict. In view of this the examiner choses to rely on the observation in the "Intrahepatic" article that the wire does deform between the soldered joints. (It is noted that both the wire and the soldered joints may be deformed to at least some extent to meet the claim limitations).

Applicant has attempted to provoke an interference with U.S. Patent 4,733,655 and has proposed "counts" 1,3, and 4. These proposed counts, however, are not patentable to the Applicant because the Palmaz articles disclosing the device claimed in counts 1,3, and 4 were published over one year prior to the

Serial No. 244,669

-5-

Art Unit 336

filing date of this application's parent.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Examiner Ralph Lewis at telephone number (703) 557-3125.

R. Lewis:lf  
August 28, 1990

STEPHEN C. PELLEGRINO  
PRIMARY EXAMINER  
ART UNIT 336